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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,128	12/19/2001	Quinn J. Haddock	3123-397	5809

25231 7590 06/19/2006

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EXAMINER

MILLER, BRIAN E

ART UNIT PAPER NUMBER

2627

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/025,128	Applicant(s) HADDOCK ET AL.	
	Examiner Brian E. Miller	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/5/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26,28,30-39,48-52,54 and 56-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26,28,30-39,48-52,54 and 56-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claims 1-26, 28, 30-39, 48-52, 54, 56-63 are now pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/5/06 has been entered.

Claim Objections

2. Claims 12-14 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The recited "means for pressurizing" appears to have been structurally set forth in claim 1, lines 12-18.

Claim Rejections - 35 USC § 112

3. Claims 12-26, 28, 30-39, 48-52, 54, 56-63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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(a) The phrases in the above mentioned claims, i.e., “means for generating...” (claim 12), “means for pressurizing...” (claims 13, 28, 54, 63) and “means for creating a pressure...” (claim 14) are not described sufficiently in the disclosure to allow one of ordinary skill to make and or use the invention. It is unclear as to what *specific* structure, in *addition* to the structure already set forth in the corresponding independent claims (1, 15, 48, 56) that would encompass the above means plus function recitations. Until this has been specifically set forth, a patentability determination cannot be made.

(b) With respect to independent claims 15, 48 and 56, the recitation “wherein a size of said first air bearing pad is selected...and further such that said first air bearing pad generates at least about 15 percent of a total uplift force exerted on said slider body when said slider is used in said disk drive, wherein a pressure of at least about 400 psi is exerted on said first air bearing pad when said slider is used in said disk drive” would encompass a scope of enablement problem. While the disclosure is enabled for a specified first air bearing pad size, the recited language could and would encompass more than the disclosed specified size(s). Furthermore, there would be other factors that would contribute to uplift forces and pressures on air bearing surfaces that is not sufficiently described in the disclosure. The language set forth in the claims would not enable one having ordinary skill in the art to make and/or use the invention without undue experimentation and would encompass unlimited “sizes” of air bearing pads which applicant should not be entitled to.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 12-26, 28, 30-39, 48-52, 54, 56-63 are further rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) The independent claims (15, 48, 56) are essentially incomplete for omitting sufficient structure to produce the claimed results, i.e., “such that said first air bearing pad generates at least about 15 percent of a total uplift force exerted on said slider body when said slider is used in said disk drive, wherein a pressure of at least about 400 psi is exerted on said first air bearing pad when said slider is used in said disk drive,” as recited in the above claims. Without sufficient recited structure, one having ordinary skill would not be able to make and/or use the invention without undue experimentation;

(b) claims 12-14, 28, 54, 63 do not appear to invoke 35 USC § 112 sixth paragraph, such that the language does not meet the third “prong” of the “3-prong analysis” as set forth in the MPEP section 2181(I), which states “the phrase ‘means for’ or ‘step for’ must not be modified by sufficient structure, material or acts for achieving the specified function.” Claim 1 appears to include specific structure that would modify the claimed “means for” recited in dependent claims 12-14, thus precluding a 112 sixth paragraph interpretation.

*Due to the extensive 112(1) and (2) problems, as set forth, supra, a determination on prior art (and thus patentability) can not be determined with respect to claims 12-26, 28, 30-39, 48-52, 54, 56-63.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5, 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Kohira et al (US 6,556,381). (As per claim 1) In so far as the claims are definite, understood and sufficiently enabled, Kohira et al discloses a slider 1 for a disk drive, as shown primarily in FIGs. 1-2 & 16, including: a slider body 1 that extends along a first reference axis “A” that defines a longitudinal extent of the slider body which includes upper (unnumbered) and lower 4 surfaces, wherein the lower surface 4 projects toward a storage medium of the disk drive when the slider is installed therein (see FIG. 3); a leading edge 2 and a trailing edge 3 longitudinally spaced from the leading edge relative to the first reference axis “A”, wherein the storage medium moves relative to the slider when incorporated in the disk drive in a direction that is at least generally from the leading edge to the trailing edge (as known in the art); first and second sides (unnumbered though depicted in the FIGs.) that are laterally spaced relative to the first reference axis “A”; the lower surface of the slider body further including a first air bearing pad 5a; a first air pressurizing step d1+d2 (adjacent pad 7a) associated with the first air bearing pad and that is disposed immediately in front of the first air bearing pad in the direction of the leading edge 2; wherein an area bounded by the leading edge, trailing edge, first side and the second side is of a first magnitude, e.g., $1\text{ mm} \times 1.25\text{ mm} = 1.25\text{ mm}^2$ (col. 4, line 15), a surface area of the first air bearing pad is of a second magnitude, e.g., 1000 nm^2 (col. 10, line 35), such that a ratio of the second magnitude to the first magnitude is no more than about 0.004, e.g., $1000\text{ nm}^2/1.25\text{ mm}^2 = 0.0008$, which ratio meets the claimed ratio; wherein a transducer 9 is disposed within the first

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air bearing pad; (as per claim 2) wherein it is considered at least part of the first air bearing pad 5a is disposed within about 0.002 in (0.051mm=50,800nm) of the trailing edge, e.g., the pad is right on the edge (see FIG. 2 which should be around the thickness of d1 is deep, i.e., 10-50nm); (as per claim 3) wherein the first air bearing pad is centrally disposed on the first reference axis "A"; (as per claim 4) wherein the first air bearing pad has a surface area of no more than about $0.00001\text{in}^2=0.00645\text{mm}^2$ which is much bigger than 1000nm^2 the max that Kohira et al discloses (see col. 10, line 35); (as per claim 5) wherein the depth of the first pressurizing step (d1+d2) is within a range of about 0.5microinches to about 3microinches, i.e., 12.7nm-76.2nm, e.g., d1 is about 10-50nm, while d2 is about 50-200, so it follows that d1+d2 is about 60-250nm (see col. 9, lines 25-45) which would fall into the aforementioned range; (as per claim 7) Kohira et al further includes a second air bearing pad 7a in which the first air bearing pad is disposed on and protrudes from the second air bearing pad; a second pressurizing step d2 and/or d3 associated with the second air bearing pad that is disposed immediately in front of the second air bearing pad in the direction of the leading edge (as shown in FIG. 2); (as per claims 8-9) wherein the depth of the second pressurizing step d3 is different (and greater) from the depth of the first pressurizing step.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 6, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohira et al (6,556,381). For a full description of Kohira et al, see the rejection, supra. In the above claims, claims 6, 11 require a depth of the first pressurizing step to be “about 1.5 microinches”; and claims 10, 11 require a depth of the second pressurizing step to be within the range of “about 3 microinches to about 8 microinches”, which dimensions are not disclosed by Kohira et al. It is considered, however, that lacking any criticality and/or any unobvious or unexpected results, that it would have been obvious to a skilled artisan to have modified the dimensions in Kohira et al to have arrived at the claimed dimensions. The motivation would have been: absent a showing of criticality, i.e., unobvious or unexpected results, the relationships set forth in these claims would have resulted through the course of routine engineering optimization/experimentation.

Additionally, the law is replete with cases in which the mere difference between the claimed invention and the prior art is some range, variable or other dimensional limitation within the claims, patentability cannot be found.

It furthermore has been held in such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range(s); see *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Moreover, the instant disclosure does not set forth evidence ascribing unexpected results due to the claimed dimensions; see *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), which held that the dimensional limitations failed to point out a feature which performed and operated any differently from the prior art.

Response to Amendment

11. Applicant's arguments filed 4/5/06 have been fully considered but they are not persuasive.

A...Applicant submits on page 15 of the "Remarks" section that "Means plus function clauses are of course allowable under 35 USC § 112, paragraph 6. The specification as filed clearly complies with 35 USC § 112, paragraphs 1 and 2, in relation to the various means plus function claim elements presented in the pending claims."

The Examiner respectfully disagrees. It is noted that only claims 12-14, 28, 54, 63 include such "means for" language, however, as set forth in the 35 USC § 112, paragraph 2 rejection set forth, *supra*. The rejection was modified in view of applicants' remarks of attempts of invoking 35 USC § 112, paragraph 6. None of the specific passages cited by applicant appears to address this *additional* "means for generating" structure, which is different then what is presently recited in the independent claims, and thus do not meet the "3-prong analysis" for properly invoking this statute (see MPEP 2181 (I).

*It is noted that claims 15, 48, 56 (and their dependents), have also been rejected under 35 USC § 112, paragraphs 1 and 2, for other reasons, however, they have not been addressed by applicant.

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B...Applicant asserts that the reference to Kohira et al (US 6,556,381) with a filing date of 1/18/01, would not be considered prior art in view of applicant's provisional application, having a filing date of 12/20/00.

This is found unpersuasive, since, in order to obtain benefit of the filing date of the provisional application, the provisional application must disclose and support the now claimed invention in the non-provisional application. After reviewing the as filed provisional application (60/257,122), it is the Examiner's position that the presently claimed invention is not completely supported or disclosed therein, thus, the benefit of the filing date of the provisional application is not "granted". While the Examiner concedes that the provisional application sets forth a "highly pressurized micropad ABS design that is pressurized to greater than 500 psi," no specific structural dimensions have been set forth to obtain this result that would reasonably enable one having ordinary skill in the art to make and/or use the invention. The statement made by applicant "where by measurement the ratio of the area of this micropad to the area within the perimeter of the lower surface of the slider body is no more than about 0.004." can in no way be construed to be accurate as drawings are not usually to scale. Irrespective to this, there are many more claimed features that are not supported by the provisional application.

In conclusion, the filing date of the Kohira et al (US 6,556,381) reference is 1/18/01, which date would constitute prior art with respect to applicant's filing date of the non-provisional application of 12/19/01, and the rejections based on Kohira et al have been maintained.

C...Applicants' comment on page 17 appears to be incomplete and as a result fails to comply with 37 CFR 1.111(b) because it amounts to a general allegation that the claims define a

patentable invention without specifically pointing out how the *language of the claims* patentably distinguishes them from the reference.

Conclusion

11. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Miller whose telephone number is (571) 272-7578. The examiner can normally be reached on M-TH 6:30am-4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'B. E. Miller', with a stylized flourish at the end.

Brian E. Miller
Primary Examiner
Art Unit 2627

BEM
June 7, 2006